

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number 042933/302185

(filed with the Notice of Appeal)

Application Number 09/920,888

Filed August 3, 2001

First Named Inventor Brian Davidson

Art Unit 2614

Examiner Elahee, Md S.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

Respectfully submitted,



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Attachment
Reasons for Requesting Pre-Appeal Brief Request for Review

Claims 7-10 and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Beerman, Jr. et al. (U.S. Patent No. 6,084,952, hereinafter “Beerman”) in view of Parry (U.S. Patent No. 7,002,703). Applicants respectfully disagree

Independent claim 10 recites, *inter alia*, a processor being configured to use an identity tag to obtain address information via a network and authorize the downloading of information not otherwise addressed to any particular entity via the network to a remote server or terminal identified by the address information associated with the identity tag, in response to receipt of the identity tag.

Beerman is directed to a system for connecting a remote device to a server via a telephone. The Office Action alleges that the disclosure of Beerman related to establishing a connection from the remote device to the server to send emails to other devices corresponds to the above recited feature of the present application. In this regard, the Office Action cites col. 12, lines 42-45 and col. 13, lines 1-7 of Beerman as disclosing the above recited feature with the exception of downloading information, which the Office Action asserts is disclosed by Parry.

The Office Action cites Beerman as disclosing an identity tag indicative of the portable communication device at col. 9, lines 25-31, in which an authentication of a remote device (12) is described as being performed based on remote device identification information transmitted by the remote device (12). In this regard, pages 2-3 of the Office Action indicate that col. 9, lines 25-31 of Beerman discloses that information system (88) of the messaging server (18) (which the Office Action asserts to correspond to an object device) identifies a remote device (12) based on the identity of the device. However, the cited passage relates to the remote device (12) identifying itself to the information system 88 to authenticate the remote device (12). Thus, the information system (88) does not “identify” the remote device (12), but instead uses the identification information provided by the remote device (12) to attempt to authenticate the remote device (12).

However, even if the identification of the remote device (12) in this disclosure of Beerman were assumed to be accomplished via some sort of identity tag, Beerman still fails to teach or suggest the use of such an identity tag for obtaining address information via a network and authorizing the downloading of information not otherwise addressed to any particular entity

via the network to a remote server or terminal identified by the address information associated with the identity tag, in response to receipt of the identity tag as provided in independent claim 10. Of note, the Office Action goes on to assert that Beerman's disclosure at col. 13, lines 1-7 and 27-29 "clearly means that the processing device uses the identity of the remote device to obtain address of the recipient's device (for example 'fax machine' of recipient) and authorize the distribution of information via the network to a remote server or terminal identified by the address information associated with the identity tag." Applicants respectfully submit that this assertion is incorrect.

Specifically, Applicants respectfully assert that Beerman's disclosure at col. 13, lines 1-7 and 27-29, and in fact all of Beerman, fails to teach or suggest using an identity tag to obtain address information via a network much less using an identity tag to obtain address information via the network and authorizing the downloading of information not otherwise addressed to any particular entity via the network to a remote server or terminal identified by the address information associated with the identity tag, in response to receipt of the identity tag.

Beerman describes creation of a communication session between a messaging server (18) and a remote device (12) (col. 12, lines 42-45). Col. 13, lines 1-7 then describes a process whereby the messaging server (18) determines whether there are outbound facsimile or email messages to be sent to recipients as indicated by the "addressee" field of the messages. Accordingly, in Beerman, there is no disclosure of the use of an identity tag (alleged to correspond to use of the remote device identification information of col. 9, lines 25-31 of Beerman) for obtaining address information for a terminal to which information should be downloaded. Rather, the address information for devices to which information is to be sent according to Beerman is located in the addressee field of each message and the addressee field associated with an email and/or a facsimile as described in Beerman is not disclosed as being obtained via the network using the identity tag as provided in independent claim 10. Contrary to the claimed invention, which obtains address information via the network using the identity tag, an address populating the addressee field of Beerman is provided by the remote device itself. Furthermore, the addressee field of Beerman is not disclosed as being associated in any way with the identity tag, as provided in independent claim 10, much less being obtained via the identity tag.

As indicated above, the Office Action states that the disclosure of Beerman “clearly means that the processing device uses the identity of the remote device to obtain address of the recipient’s device (for example ‘fax machine’ of recipient)”, but this cannot be. In this regard, the statement above would require that the remote device’s identity be used to determine the fax number. However, this is clearly not the case as the fax number is conventionally and manually provided. There is no disclosure of Beerman to suggest that the remote device’s identity is used to determine the address of any recipient device, much less a fax machine. Thus, Beerman fails to teach or suggest using an identity tag to obtain address information via the network and authorizing the downloading of information not otherwise addressed to any particular entity via the network to a remote server or terminal identified by the address information associated with the identity tag, in response to receipt of the identity tag as recited in independent claim 10.

Furthermore, even if one were to assume for the sake of argument that by finding outbound email or faxes to be sent from the processing subsystem, Beerman discloses using an identity tag to obtain address information (an assumption with which Applicants expressly disagree), Beerman still fails to teach or suggest that information not otherwise addressed to a particular entity is downloaded to a remote server or terminal identified by the obtained address information as provided in independent claim 10. In this regard, the information downloaded in accordance with embodiments of the present invention is not information which, like the email or fax messages disclosed in Beerman, is addressed to a particular entity. To the contrary, the information provided in Beerman is quite clearly directly addressed to a particular entity since the provided information is one of an outbound facsimile or E-mail, “which are to be sent to recipients as indicated by the ‘addressee’ field of the messages.” In fact, the “To” or “addressee” fields of Beerman clearly indicate that the information communicated in Beerman is addressed to a particular entity. To the contrary, the claimed invention provides for the downloading of information that is not otherwise addressed to any particular entity, thereby further distinguishing the claimed invention from Beerman. Moreover, Beerman includes no disclosure whatsoever related to either using the identity tag to obtain address information or downloading information in response to receipt of the identity tag. Thus, Beerman fails to teach or suggest using an identity tag to obtain address information via the network and authorizing the downloading of information not otherwise addressed to any particular entity via the network to a remote server or

terminal identified by the address information associated with the identity tag, in response to receipt of the identity tag as provided in independent claim 10.

Applicants also respectfully note that an identity tag according to the claimed invention is “indicative of the identity of the portable radio communication device”. In a previous response, Applicants pressed the point that an email is not indicative of the identity of any particular device and therefore an email address cannot correspond to an identity tag of the claimed invention. In this regard, an individual addressee of an email can, via the same email address, receive the email at any of a number of different devices since the email address is indicative of an individual account and not a particular device. The same is true of a facsimile. There is no identity tag indicative of the portable radio communication device associated with a facsimile recipient or sender either, since any of a plurality of devices having corresponding fax capabilities could generically be used to send or receive a fax. Thus, even if one were to consider the “To” or “addressee” field identifying the addressee of an email or fax as being an identity tag used to obtain address information via the network, such a consideration would foreclose the possibility of the identity tag reading on the claimed invention since the identity tag would not be indicative of the device transmitting the identity tag.

Thus, for all the reasons provided above, regardless of which element of the disclosure of Beerman is read to correspond to the claimed identity tag, Beerman still fails to teach or suggest a processor being configured to use an identity tag to obtain address information via a network and authorize the downloading of information not otherwise addressed to any particular entity via the network to a remote server or terminal identified by the address information associated with the identity tag, in response to receipt of the identity tag as provided by independent claim 10.

Parry is directed to devices that control the downloading of information via email messages (col. 9, line 15). As pointed out in Applicants’ prior response, Parry also fails to teach or suggest a processor being configured to use an identity tag to obtain address information via a network and authorize the downloading of information not otherwise addressed to any particular entity via the network to a remote server or terminal identified by the address information associated with the identity tag, in response to receipt of the identity tag as provided in independent claim 10. The Office Action currently only cites Parry for the limited aspect of downloading information. However, even assuming Parry discloses this limited aspect, Parry is

not sufficient to cure the above stated deficiencies of Beerman. Furthermore, Parry is not cited as such.

Since Beerman and Parry each fail to teach or suggest a processor being configured to use an identity tag to obtain address information via a network and authorize the downloading of information not otherwise addressed to any particular entity via the network to a remote server or terminal identified by the address information associated with the identity tag, in response to receipt of the identity tag as provided in independent claim 10, any combination of the cited references likewise fails to render independent claim 10 obvious for at least the same reasons described above. Independent claims 7, 8 and 12 include similar recitations to the above recited feature of independent claim 10 and are therefore patentable for at least the same reasons given above for independent claim 10. Dependent claim 9 depends directly from independent claim 8 and therefore includes all the recitations of independent claim 8. Thus, dependent claim 9 is patentable for at least those reasons given above for independent claim 8.

For all the reasons stated above, Applicants respectfully submit that the rejections of claims 7-10 and 12 are overcome.